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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,586	12/27/2001	Tracee E.J. Eidenschink	1001.1459101	1707

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EXAMINER	
NGUYEN, VI X	

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/034,586	EIDENSCHINK, TRACEE E.J.	
	Examiner	Art Unit	
	Victor X Nguyen	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,5,12 and 23-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The embodiment of figures 1 and 4, as described in the specification and shown in the drawings, is incapable of being used. It is unclear from the specification and drawings where the adjacent raised shapes are separated when the shaft is not being torqued. Whether they are separated at the shaft or at the bearing point (26). Furthermore, it is not seen how at least two adjacent raised shapes move toward one another when the shaft is torqued (which is not disclosed in figures 1 or 4).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 11-13 and 20-22 are rejected under 35 U.S.C. 102 (b) as being anticipated by Jaraczewski et al (4,817,613).

Jaraczewski et al disclose in figs 1-2, a catheter for use during a surgical procedure on a body, including: an elongate shaft (10); a raised/tread pattern (as best seen in fig. 2, element 14 is described as a braided material or tread pattern) disposes on the outer surface. The raised/tread pattern comprises a plurality of diamond shapes (the pitch angle of element 14 can be characterized as a diamond shape). Note that the catheter of Jaraczewski in fig. 2 is capable of improving the transmission of torque along the elongate shaft when torqued (see col. 5, lines 50-67); and where adjacent raised shapes are separated when the shaft is not being torqued and where at least two adjacent raised shapes move toward one another when the shaft is torqued (please see the above 112-first rejection).

Regarding claims 3-4, Jaraczewski et al disclose discloses the transmission of torque comprises a plurality of bearing points (the intersection is between element 12 and 14) that contacts one another when the elongate shaft is torqued.

Regarding claims 5, 11-13 and 20-22, Jaraczewski et al disclose in figs. 1-2, including: an elongate shaft (10); a raised/tread pattern disposes on the outer surface. The raised/tread pattern comprises a plurality of bearing points that contacts one another when the elongate shaft is torqued, and where the catheter is a guide catheter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-10 and 14-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Jaraczewski et al (4,817,613).

Regarding claims 6-7 and 15-16, the recited claims, "the raised pattern is formed by laser ablation or by overmolding" is not given any patentable weight since this is a product by process limitations that are not constructed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made patentable. In Re Klug, 333 f2d 742, 180 U.S.P.Q. 161 (CCPA 1974). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the raised pattern is formed by laser ablation or by overmolding, since a comparison of the recited process with the prior art process does not serve to resolve the issue concerning patentability of the product. Regarding claims 8-10 and 17-19, the recited claims "the raised pattern is formed by hot die casting/embossing or by extrusion" is not given any patentable weight since this is a product by process limitations that are not constructed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made patentable. In Re Klug, 333 f2d 742, 180 U.S.P.Q. 161 (CCPA 1974). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the raised pattern is formed by hot die casting/embossing or by extrusion, since

a comparison of the recited process with the prior art process does not serve to resolve the issue concerning patentability of the product.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Jaraczewski et al (4,817,613) in view of Moore et al (4,669,465).

Regarding claim 14, Jaraczewski is explained as before. However, Jaraczewski does not disclose the catheter is a balloon catheter.

Moore et al teach the catheter is a balloon catheter (fig. 1 and col. 2, lines 25-27). It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Jaraczewski by making the catheter is a balloon catheter as taught by Moore et al in order to create an overall system with added capability into a body lumen.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 5 and 12 have been considered but are moot in view of new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejection above where examiner addresses applicant's concerns regarding prior art rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No.6,165,163 to Chien U.S. Pat. No. 4,425,919 to Alston

U.S. Pat. No.5,700,253 to Parker U.S. Pat. No. 6,607,505 to Thompson

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn
12/21/2004

Julian W. Woo

JULIAN W. WOO
PRIMARY EXAMINER